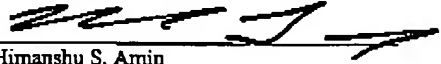


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CERTIFICATE OF FACSIMILE TRANSMISSION

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MAR 22 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Applicant(s): Ynijun P. Wang, *et al.*

Examiner: Romain Jeanty

Serial No: 10/016,001

Art Unit: 3623

Filing Date: December 10, 2001

Title: UNIVERSAL PRODUCT INFORMATION LOOKUP AND DISPLAY SYSTEM

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPEAL BRIEF

Dear Sir:

Applicants' representative submits this brief in support of an appeal for the above identified application. The commissioner is authorized to charge the requisite \$500 fee, to the credit card designated on the enclosed credit card payment form. In the event any additional fees are due in connection with this submission, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1063 [TELNP333US].

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I. Real Party in Interest (37 C.F.R. §41.37(c)(1)(i))

The real party in interest in the present appeal is Symbol Technologies, Inc., the assignee of the subject application.

II. Related Appeals and Interferences (37 C.F.R. §41.37(c)(1)(ii))

Appellants, appellants' legal representative, and/or the assignee of the subject application are not aware of any appeals or interferences which may be related to, will directly affect, or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims (37 C.F.R. §41.37(c)(1)(iii))

Claims 1-4 and 16-23 have been rejected by the Examiner. The rejection of claims 1-4 and 16-23 are being appealed.

IV. Status of Amendments (37 C.F.R. §41.37(c)(1)(iv))

No claim amendments have been entered after the Final Office Action.

V. Summary of Claimed Subject Matter (37 C.F.R. §41.37(c)(1)(v))**A. Independent Claim 1**

The invention as recited in independent claim 1 relates to a method of capturing demographic information regarding a consumer of products, and providing such information to a manufacture of such product. The consumer scans a bar code symbol on a product; and by providing an association table, an inquiry is made to the product manufacturer (*See e.g.*, Fig. 2 block 66, page 9 lines 8-20, and page 10 lines 3-15.) Demographic information of the consumer is supplied to the manufacture by utilizing data packet information transferred to the manufacturer, as a result of the information inquiry. (*See e.g.*, page 10 lines 3-15.) The data packets can be in a form of TCP/IP protocols, as referred thereto throughout the Specification. (*See e.g.*, page 7 lines 3-10, page 7 lines 7-12.) Such can facilitate targeted marketing; follow up information, and other related marketing activities. (*See e.g.*, page 10 lines 3-15.)

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B. Independent Claim 16

Applicants' claimed invention as recited in independent claim 16 relates to exchanging data between potential consumers and manufacturers by determining web site address affiliation with product identifying indicia scanned by a bar code reader with a Mapping Service Provider (MSP). (*See e.g.*, Fig. 1 block 64, Fig. 2 block 72, page 8 lines 13-22, and page 7 lines 7-12.) Accordingly, the internet can be employed to transmit demographic information about the consumer to the product manufacturer by utilizing information transferred within the web page request. (*See e.g.*, page 8 lines 13-22, and page 7 lines 7-12.) Such can provide a data query and acquisition system for product information that largely utilizes an already existing hardware/software infra structure, and further supplies a system for acquiring demographic information relative to consumers. (*See e.g.*, page 4 lines 20-22, and page 5 lines 1-4.)

C. Independent Claim 22

The subject invention as recited in independent claim 22 relates to a method of providing manufacturers with demographic information about consumers utilizing the internet and transmitting demographic information about consumers to the product manufacturer by determining web site address affiliation with product identifying indicia scanned by a bar code reader with a mapping function. (*See e.g.*, page 9 lines 11-14.) The demographic information can be transmitted *via* employing a Domain Name Service to translate Internet Protocol (IP) mapping information transferred by the consumer when requesting a page. (*See e.g.*, page 7 lines 4-14, and page 11 lines 10-15.)

VI. Grounds of Rejection to be Reviewed (37 C.F.R. §41.37(c)(1)(vi))

A. Claims 1-3 and 16-23 stand rejected under 35 U.S.C. §103(a) as being obvious over Hudetz, *et al.* (U.S. Patent 5,978,773) in view of Dialog (article entitled Home Centers.)

B. Claim 4 stands rejected under 35 U.S.C. §103(a) as being obvious over Hudetz, *et al.*, in view of Dialog, and further in view of Kaplan (U.S. Patent 5,963,916).

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VII. Argument (37 C.F.R. §41.37(c)(1)(vii))**A. Rejection of Claims 1-3, and 16-23 Under 35 U.S.C. §103(a)**

Claims 1-3, and 16-23 stand rejected under 35 U.S.C. §103(a) as being obvious over Hudetz, *et al.* (U.S. Patent 5,978,773) in view of Dialog (article entitled Home Centers.) Reversal of this rejection is respectfully requested for at least the following reasons. Hudetz, *et al.*, alone or in combination with Dialog does not teach or suggest applicants' claimed invention.

i. *The cited references fail to teach providing demographic information about a consumer to a product manufacturer via utilizing data packet information transferred to the manufacturer, as a result of an information inquiry.*

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art and not based on the Applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Neither Hudetz, *et al.* nor Dialog, alone or in combination teach or suggest applicants' claimed invention. Hudetz is directed to a system for using identification codes found on ordinary articles of commerce to access remote computers on a network. Hudetz does not teach or suggest *transmitting demographic information* to the product manufacturer by utilizing an electronic medium as in applicants' claimed invention. Dialog fails to cure the aforementioned deficiencies of Hudetz, *et al.* with respect to the subject claims. Dialog, in the relevant section is directed to third party credit providers that supply ancillary marketing services to retailers - such is not providing demographic information by *utilizing data packet information transferred to the manufacturer as a result of the information inquiry*, or by utilizing information transferred *within the web page request*, as in applicants' claimed invention.

The subject invention as claimed relates to providing demographic information about a consumer to a product manufacturer by *utilizing data packet information transferred to the*

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manufacturer as a result of the information inquiry, or by utilizing information transferred *within the web page request* as respectively recited in independent claims 1, 16 and 22. Such claimed aspects facilitate targeted marketing, follow up information, and even providing a salable product of demographic information itself. In addition, manufacturers can advantageously share such information to glean valuable market information in a synergetic way.

- ii. *The motivation asserted to combine the cited art in the manner suggested by the Examiner is improper, since the purported combination teaches away from the claimed invention.*

Dialog in part recites “...the services the retailers want the most from the third party providers are cooperative advertising and promotional offers via mailing stuffers”, and teaches away from data packet utilization in an electronic medium. (Teaching away from the art of the subject invention is a *per se* demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988); A prior art reference must be considered in its entirety, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)). Hence, one of ordinary skill in the art would not have been motivated to modify/combine Hudetz, *et al.* and Dialog in a manner suggested by the Office Action – and as explained earlier even if the references are combined, applicants’ claimed invention does not result.

The Examiner further states that “electronic medium is not present in the present invention.” (See page 2 of the Advisory Action dated October 21, 2004.) Such assertion is in error, as independent claim 1 recites “utilizing *data packet* information transferred to the manufacturer”, and examples of such data packets are disclosed throughout applicants’ specification in a context of TCP/IP transmittals that employs an electronic medium. (See *e.g.*, page 7 lines 3-10, page 7 lines 7-12.)

Likewise, independent claim 16 recites “transmitting demographic information [...] within the *web page request*”- which also necessitates an electronic medium. A similar limitation of “transmitting demographic information about the consumer to the product manufacturer via employing a Domain Name Service (DNS) to *translate Internet Protocol (IP)* mapping information transferred by the consumer when requesting a *web page*”, which also necessitates an electronic medium, is recited in independent claim 22.

Accordingly, a reversal of the rejection for independent claims 1, 16, 22, and claims 2-3,

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claims 17-21, and claim 23 that respectively depend therefrom, is respectfully requested.

B. Rejection of Claim 4 Under 35 U.S.C. §103(a)

Claim 4 depends from independent claim 1, and as explained above neither Hudetz, *et al.* nor Dialog, alone or in combination teach or suggest claim 1. Kaplan (U.S. Patent 5,963,916) does not make up for the aforementioned deficiencies of Hudetz, *et al.*, in view of Dialog with respect to the subject independent claim.

In Kaplan, the demographic collection is obtained by completing a brief membership application which asks for basic demographic information for generation of an access card. (See Kaplan column 7, line 4-12). Such is not capturing and providing demographic information to a manufacture of such product that is performed for each query, by utilizing data packet information transferred to the manufacturer, as a result of an information inquiry, as in applicants' claimed invention. (See *e.g.*, page 10 lines 9-10.) Thus, neither Hudetz, *et al.*, Dialog, nor Kaplan alone or in combination, teach or suggest applicants' claimed invention.

Moreover, the Office Action's motivation to achieve the purported combination is *via* employment of applicants' specification as a 20/20 hind-sight based road map, wherein the scanner system of Hudetz, *et al.* is combined with the marketing scheme of Dialog, and further with the demographic collection/e-mail target marketing of Kaplan. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988) (citations omitted) - and as explained earlier even if the references are combined, applicants' claimed invention does not result. Accordingly, a reversal of this rejection is respectfully requested.

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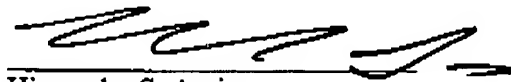
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Conclusion

For at least the above reasons, the claims currently under consideration are believed to be patentable over the cited references. Accordingly, it is respectfully requested that the rejections of claims 1-4, and 16-23 be reversed.

If any additional fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Respectfully submitted,
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VIII. Claims Appendix (37 C.F.R. §41.37(c)(1)(viii))

1. A method of capturing and providing demographic information concerning a consumer of products to a manufacturer of such products during transactions in which the consumer utilizes a bar code reader and the Internet for product inquiries, comprising:
providing the consumer with a bar code symbol reader;
scanning a uniform product code (UPC) bar code symbol on a product by the consumer;
providing an association table in a database between the UPC symbol data and an Internet web site address affiliated with the product manufacturer;
providing the associated web site address to a computing device of the consumer for allowing the consumer to make a product information inquiry to said web site address; and
providing demographic information about the consumer to the product manufacturer by utilizing data packet information transferred to the manufacturer as a result of the information inquiry.
2. A method as defined in claim 1, wherein the bar code symbol reader is provided in the consumer's home.
3. A method as defined in claim 1, wherein the demographic information includes the geographic location of the consumer.
4. A method as defined in claim 1, wherein further comprising providing targeted e-mails to the consumer for product announcements by the manufacturer.
- 5-15 (Cancelled.)

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16. A method of exchanging data between potential consumers and manufacturers using the Internet comprising:

determining at least one web site address affiliated with product identifying indicia scanned by a barcode reader utilizing a Mapping Service Provider (MSP);

providing product information to the consumer by requesting and loading a web page associated with the at least one web site address; and

transmitting demographic information about the consumer to the product manufacturer by utilizing information transferred within the web page request.

17. The method of claim 16 wherein the identifying indicia is a uniform product code (UPC).

18. The method of claim 16, wherein the Mapping Service Provider (MSP) employs a mapping function to match identifying indicia to a website address from among a list of identifying indicia and web site address mappings residing in a storage device.

19. The method of claim 16, wherein the web page includes at least one link to a related web page.

20. The method of claim 16, wherein transmitting demographic information about the consumer to the product manufacturer comprises employing cross application of Domain Name Service (DNS) to translate Internet Protocol (IP) mapping information transferred by the consumer.

21. The method of claim 20, wherein the demographic information includes the geographical location of the consumer.

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22. A method of providing potential consumers with product information and providing manufacturers with demographic information about consumers utilizing the Internet comprising:

determining at least one web site address affiliated with a product's uniform product code (UPC) scanned by a barcode reader utilizing a mapping function to match a UPC to a website address from among a list of UPCs and web site address mappings residing in a storage device

providing product information to the consumer by requesting and loading a web page associated with the at least one product web site address; and

transmitting demographic information about the consumer to the product manufacturer *via* employing a Domain Name Service (DNS) to translate Internet Protocol (IP) mapping information transferred by the consumer when requesting a web page.

23. The method of claim 22, wherein the demographic information includes the geographical location of the consumer.

IX. Evidence Appendix (37 C.F.R. §41.37(c)(1)(ix))

None.

X. Related Proceedings Appendix (37 C.F.R. §41.37(c)(1)(x))

None.